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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,795

11/21/2003

Robert R. Wood

HO-P02901US1

2945

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03/23/2006

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,795	<b>Applicant(s)</b> WOOD, ROBERT R.	
	<b>Examiner</b> Marc S. Zimmer	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/04, 9/17/04</u> | 6) <input type="checkbox"/> Other: _____  |

***Priority***

The Examiner's earlier position that Applicant has no valid claim to priority to an earlier-filed application has not been disputed in the reply dated December 27, 2005. Therefore, the effective filing date for the purpose of determining whether or not a reference constitutes prior art, is held as being the filing date of this application, November 21, 2003.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Paragraph 21 of the Specification states simply that the rubber particles may expand "to" 140% of their original size thereby suggesting that this is the maximum amount of expansion that can be expected. Claims 6 and 9, by contrast, recite a degree of expansion of at least 140% thus indicating that this is a minimum amount of expansion observed. These statements are clearly conflict and correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Concerning claims 1-6, these claims are directed to a "drilling fluid additive", or additive for drilling fluids, comprising only a crumb rubber of a specified particle size yet Applicant has added a limitation to these claims that suggests that it had been their intent to, instead, claim the drilling fluid itself to which is added said rubber. It is submitted that, were this Applicant's intent, they could amend the claim to recite the other contents of the fluid, which would at least include a diluent. (A diluent is mentioned in claim 2, which only creates further confusion as to what Applicant regards as their invention insofar as the claims are directed to an additive, not additives. It is conceded that an additive may comprise more than one component but then it is difficult to distinguish the drilling fluid additive from the drilling fluid itself.) Of course, were Applicant to amend claims 1-6 in this manner, they would then resemble claims 7 to 9.

The newly added limitation is not further limiting of the additive but, rather, the amount of additive were it described in the context of being a component of a larger composition. For the purpose of evaluating claims 1-6 against the prior art, this limitation has been ignored.

Claims 7-9, like claims 1-6 recite a drilling fluid additive (everything that follows in the preamble is intended use and, hence, immaterial to a determination of patentability- the prior art need only teach a similarly constituted composition *capable of* functioning in

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the stated capacity) but, in actuality, the body of the claim is reflective of a composition as opposed to an additive. It is the Examiner's position that claim 7 should be rewritten to recite a drilling fluid or, alternatively, a drilling fluid composition.

### ***Claim Analysis***

Applicant is advised that the crumb rubber particles are, for the purpose of Examination, deemed to all be in excess of 400 microns but less than 4000 microns. That is to say, this parameter of the invention is not delineated as an *average* particle size wherein it is expected that there would have been particles of sizes less than- and greater than 400 microns contributing to an average of 400 microns. The Examiner is not relying on any reference at this time that discloses an average particle size because it is not possible to know with any certainty that all of the particles contributing to the average are within the limits set forth by Applicant.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood, U.S. patent # 6,518,224. Simply put, Wood discloses a preferred particle size of 20-400 microns there, thusly, being overlap with the claimed range at 400 microns. Moreover,

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similar quantities of crumb rubber per barrel of fluid are disclosed in column 5, lines 41-43.

Applicant's are advised that any attempts to obviate this rejection by simply stipulating that the particles are greater than 400 microns in diameter will be met with a rejection under 35 U.S.C 103.

The prior art rejections over *Knapp* and *Brothers* are hereby withdrawn, but not for the reasons set out in Applicant's arguments. Both references do, in fact, recite an amount of material added (*Knapp* at the bottom of column 4 and *Brothers* in column 3, lines 16-24). However, the amount prescribed by *Knapp* is less than that required by the claims and the units employed by *Brothers* cannot be correlated with those presently used unless the weight of all contents of a barrel is known. Rejection of claims 1, 3, and 6 over *Benko* is withheld until such time that Applicant clarifies the matter concerning particle size, i.e. whether the reported particle size is an average particle size. Applicant must furnish evidence in support of any contention that the concept of an average particle size is suitably enabled by the original disclosure if that is their position.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 20, 2006

  
MARC S. ZIMMER  
PRIMARY EXAMINER